

REMARKS

Objections to the specification

The Examiner maintains his objection that the specification contains embedded hyperlinks, and request that these hyperlinks be removed. The Examiner has invited Applicant's attention to MPEP §608.01, wherein Applicant learned that "[w]here the hyperlinks and/or other forms of browser-executable codes themselves rather than the contents of the site to which the hyperlinks are directed are part of applicant's invention and it is necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. § 112, first paragraph, and applicant does not intend to have these hyperlinks be active links, examiners should not object to these hyperlinks. The Office will disable these hyperlinks when preparing the text to be loaded onto the USPTO web database." (emphasis added) Applicant notes that both instances of URLs in the specification, at pages 10 and 11, are clearly not intended to be active hyperlinks, and are not provided in order to incorporate the contents of the sites to which they are directed into Applicant's invention. Rather, they are clearly and expressly provided to help the reader find "basic information relating to the DMI programming interface" and "the well-known rules laid down in the Request For Commands (RFC) 2.6.1.6" protocol, to thereby comply with the requirements of 35 U.S.C. § 112. Applicant thus respectfully renews his request that the Examiner withdraw this objection.

Objections to the claims

Claim 16 stands objected to because it includes reference characters DMI and WMI that are not enclosed in parentheses. As clearly set forth in the disclosure, DMI and WMI are not reference characters. DMI is an acronym for Distributed Management Interface and WMI is an acronym for Windows Management Instrumentation (specification, page 4, lines 8-9). Applicant submits that the Examiner's invocation of MPEP § 608.01(m) as grounds for requiring that these acronyms be placed in parentheses is misplaced, and respectfully requests the Examiner to withdraw this objection.

Double Patenting

Claims 1-25 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of co-pending Application S/N 09/765,049 and claims 1-20 of co-pending Application S/N 09/993,979. The Examiner asserts that the claims, though not identical, are not patentably distinct from each other because “it would have been obvious to a person skill in the art to recognize that the claims are similar because all three applications are used to provide related services to users with considering of using user’s references or system profiles in the requests and responses.” Applicant fails to recognize in the Examiner’s proffered reasoning an adequate basis for rejecting the claims under the judicially created doctrine of obviousness-type double patenting. The dubious fact that “it would have been obvious to a person skill in the art to recognize that the claims are similar” is most certainly not sufficient grounds to reject the claims under the judicially created doctrine of obviousness-type double patenting. “Similarity” of claims has no bearing upon the factual, objective inquiry of whether a claim would have been obvious to one skilled in the art in view of another claim. Furthermore, the Examiner’s perception that “all three applications are used to provide related services to users with considering of using user’s references or system profiles in the requests and responses” (the accuracy of which Applicant does not hereby agree to) is equally irrelevant to a determination of obviousness. The Examiner’s statement merely asserts that all three applications, in the Examiner’s view, are directed to solving the same problem. An obviousness inquiry must concern itself not with similarity of problem, but rather with obvious similarity of the claimed solutions to the common problem.

Applicant thus respectfully submits that the Examiner has failed to properly substantiate the instant double patenting rejection. The Examiner clearly recognizes that, at the very least, the “claim of ‘049 and ‘979 applications do not specifically state the abstract requests as described in the claim 1 of the instant application.” Whether a skilled person would have recognized that “the claims are similar” because they provide related services or not is completely irrelevant with respect to whether the same skilled person would have actually found one claim obvious in view of another claim. The Examiner has failed to make a proper assertion that the claims are obvious in view of one another, or to set forth a sufficient nexus between the subject matter of the claims of the three applications and thus, especially in view of the Examiner’s own admission that the

claims of the '049 and '979 applications do not recite all limitations of the present claims, Applicant respectfully requests that the Examiner withdraw the present provisional double patenting rejection.

Rejection under 35 U.S.C §112

Claims 2, 11-15, and 17 stand rejected under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner finds that certain terms in claims 2 and 15 lack antecedent basis, and that claims 11-15 and 17 are unclear as to whether they are drawn to a method or to a product.

Applicant respectfully disagrees with the Examiner's view. Claim 2 recites "said profile" and is dependent from claim 1, which recites "a local profile." Applicant submits there is sufficient antecedent basis for "said profile" in claim 1. Similarly, claim 15 claims a computer program product as claimed in claim 12. Claim 12 recites "a personal computer, the program code elements being implemented as a local agent for execution on the computer." Thus, Applicant submits that claim 12, by reciting program code elements implemented for execution on a computer, provides sufficient antecedent basis for "a computer program product." Furthermore, Applicant submits that claims 11-15 and 17 are very clearly and unambiguously drawn to products. Claims 11-15 are drawn to a transaction aid comprised of various program code elements. The fact that the program code elements must by necessity be described in terms of their functionality does not render the scope of the claims unclear, contrary to the Examiner's assertion. Claim 17 is similarly worded.

In view of the preceding, Applicant submits that the claims are clear and definite, and respectfully requests the Examiner to withdraw this rejection.

Rejection under 35 U.S.C. §103

Claims 1-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,578,142 to Anderson et al. in view of U.S. Pat. No. 6,102,969 to Christianson and, partially, further in view of U.S. Pat. No. 6,598,169 to Warwick et al. In particular, with regards to claim 1, the Examiner finds that Anderson discloses all claimed elements with the exception of receiving an abstract request formulated at a client computer and containing incomplete information identifying a potential transaction. However, the Examiner alleges that Christianson discloses receiving an abstract request formulated at a client computer (col. 3, ll. 8-11 and col. 4, ll. 42-44) and containing incomplete information identifying a potential transaction (col. 2, ll. 58-61 and col. 3, ll. 12-17). Applicant has, in his reply to the previous Office Action, explained in detail that Christianson does not in fact disclose the claim limitations alleged by the Examiner. In the present Action the Examiner appears to reach for other portions of the Christianson disclosure to support the instant rejection, and Applicant is once again compelled to respectfully disagree with the Examiner's understanding of this reference.

The passages in Christianson currently cited by the Examiner teach that "in one aspect the invention includes a method for efficient access to information sources on a network comprising preferably ana [sic] or more of the following steps: receiving a user query for information" and that "the user interface module interacts with the user to receive user queries for information." There is nothing in these passages, nor indeed in any other passage in Christianson, that may be understood as disclosing the receiving of an abstract request formulated at a client computer. "Abstract request" as used in the present claims and read in light of the specification (see, e.g., page 7, line 32 to page 8, line 2) refers to a request for a transaction that only contains "some basic incomplete information" or "only partial information" for completing the requested transaction. The claim language itself clearly sets forth that the abstract request contains "incomplete information identifying a potential transaction." There is nothing in Christianson discussing requests for transactions, nor discussing incomplete or only partial requests for transactions, information, or anything else for that matter.

The passages cited by the Examiner further teach that "information source responses are parsed and understood so that only the relevant data items are extracted for user presentation.

Duplicate, stale, and irrelevant information items are discarded" and "determining the information sources most relevant to this query; retrieving a description of each information source; formatting the query according to this description in a manner suitable for each information source and transmitting the formatted query to the source; receiving responses from the information sources..." These passages have absolutely nothing to do with a user request, whether it's for a transaction, for information, or for something completely different. These passages discuss Christianson's approach to responding to the user's request, and have no bearing whatsoever upon Applicant's claimed limitations alleged by the Examiner to be disclosed by Christianson.

Applicant declines to comment upon the Examiner's characterization of Anderson because it is not necessary, but notes expressly that the present response is not to be understood as acquiescing to the Examiner's statements regarding Anderson.

Applicant respectfully reminds the Examiner of the requirements posited by MPEP 2143.03 that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." (emphasis added) The Examiner has not made, and indeed cannot make, a *prima facie* showing that Christianson discloses receiving an abstract request formulated at a client computer and containing incomplete information identifying a potential transaction. Applicant therefore submits that claim 1 is allowable and respectfully requests the Examiner to reconsider and pass the claim to issue.

Claims 2-9, and 14 depend from claim 1. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, in light of the above discussion of claim 1, Applicant submits that claims 2-9 and 14 are also allowable.

With regards to claim 10, the Examiner simply informs Applicant that "it is rejected for similar reasons a stated above in claim 1." Applicant cannot understand how the reasons for rejecting claim 10 can be similar to those for rejecting claim 1, in view of the fact that claim 10

recites limitations that are not recited by claim 1. Thus, for instance, claim 10 recites “detecting a condition of insufficient resources.” The Examiner has made no allegation of any of the cited references disclosing this limitation. Applicant has reviewed all references with care, and cannot find any discussion that can even obliquely be understood as disclosing detecting a condition of insufficient resources, as well as other claimed limitations. Applicant thus once again is compelled to respectfully submit that the Examiner has not made a *prima facie* showing that the cited art discloses all the claims limitations, and respectfully requests the Examiner to reconsider and pass claim 10 to issue. Applicant takes note that the Examiner proffered a similarly unsupported rejection in the previous Action, and Applicant went to great lengths in his previous reply to remind the Examiner of his duty under 37 C.F.R. 1.104(c), all of which the Examiner appears to have ignored in view of the present Action. Applicant respectfully requests the Examiner yet again to be mindful of his obligations under the rules and encourages the Examiner to read both the instant application as well as the cited prior art documents before issuing the next Action.

Claim 11 is also “rejected for similar reasons a stated above in claim 1.” Applicant submits that claim 11 is in fact nonobvious and patentable for similar reasons as stated above with respect to claim 1, and respectfully requests the Examiner to reconsider and pass claim 11 to issue.

Claims 12-13 and 15 depend from claim 11, and Applicant submits that these claims are therefore also allowable.

With regards to claim 16, the Examiner alleges that Warwick discloses that profile parameters are collected by means of an interrogation via DMI or WMI, and directs Applicant’s attention to the Abstract. Applicant directs the Examiner’s attention to the rest of the patent, which, just like the abstract, does not contain the terms “profile” or “transaction” even once. The abstract itself informs the careful reader that “[t]he WMI system provides an interface through which instrumented components, such as hardware devices, can provide information and notification to management applications in user mode through a consistent management information store.” The very first sentence of the abstract clearly informs the reader that the invention disclosed therein “provides a mechanism for exposing to user mode applications the

features and information enabled by the Advanced Configuration and Power Interface ("ACPI") specification." As those skilled in the art already know, and those who do not can learn from the Background section of Warwick if they are so inclined, the ACPI specification is an open-industry specification "that defines an interface to a computer system board that enables the operating system to implement operating-system directed power management and system configuration." There is simply nothing in Warwick even remotely connected or connectable to a method of collecting data representative of a computer profile for achieving an electronic business transaction. The Examiner's assertion that the skilled person would have been motivated to combine Christianson, Anderson, and Warwick "because Warwick's teaching would provide an interface for mapping of data from diverse data sources in a common, normalized and logically organized way, and enables correlation and associations between the management data regardless of type, content, or source of origin" helps shed no light onto how combining these three references would result in the subject matter of claim 16. Applicant does not argue that mapping data from diverse data sources in a common, normalized and logically organized way is probably a worthwhile goal, but can see no correlation between the desire to achieve this goal and the method of claim 16. Enabling correlation and associations between management data regardless of type, content, or source of origin may be equally desirable to some but is equally irrelevant to the method of claim 16.

The above discussion is equally relevant and applicable to claim 22. Because the Examiner has once again failed to make a *prima facie* showing that the cited art, alone or in any attempted combination, discloses all the claims limitations, Applicant respectfully requests the Examiner to withdraw this rejection and pass claims 16 and 22 to issue.

Claims 17-21 and 23-25 are also variously rejected for similar reasons a stated above in claim 1 and others. Applicant thus submits that the previous discussion of claim 1 is responsive to all of these rejections, and respectfully requests the Examiner to withdraw these rejections and pass claims 17-21 and 23-25 to issue.

In view of the above, Applicants submit that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue.

A Notice of Change of Correspondence Address is filed concurrently herewith. Kindly note the new Attorney Docket Number for this case.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

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Susan Papp
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Respectfully submitted,



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